

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-21 are all the claims pending in the application. An Appeal Brief was filed in this application on September 24, 2008. An Examiner's Answer dated January 8, 2009 was subsequently issued. A Reply Brief was filed on March 9, 2009.

On April 15, 2010, the Board of Patent Appeals and Interferences issued an Order Remanding Appeal to Examiner (hereafter, "the Order"), which raised a question as to whether alleged functional language in independent claim 1 may be indefinite under 35 U.S.C. § 112, second paragraph.

In response to the Order, the Examiner has issued a new Examiner's Answer which contains new grounds of rejection. Specifically, the Examiner has rejected claim 1 under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled.

As a preliminary matter, Applicant respectfully submits that the Examiner's new ground of rejection does not mention any rejection under 35 U.S.C. § 112, second paragraph. The Order stated that "there is a question as to whether claim 1 and the claims which depend upon this claim, meet the requirements of being definite under 35 U.S.C. § 112, 2nd paragraph." (emphasis added)²

However, the Examiner's new ground of rejection is based solely on 35 U.S.C. § 112, first paragraph.

Nevertheless, the Examiner asserts:

² The order at page 2.

The claim(s) is/are drawn to only a single element instead of a combination. This recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. § 112, first paragraph.³

Applicant respectfully disagrees with the Examiner. The single means claim as recited in *In re Hyatt*, covered every conceivable means for achieving the stated purpose, and was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.

This differs from the instant invention, where, contrary to the examiner's assertion, the "means" limitation does not "every conceivable means for achieving the stated purpose", but specifically recites control means configured to be coupled to a traffic source and to an interface. As such, the enabling disclosure of the specification is clearly commensurate in scope with independent claim 1, the claim under consideration.

In order to expedite prosecution, Applicant has amended claim 1 to recite a "control device". Support for this feature of the claims can clearly be found at least in page 9 of the specification as filed, which discloses "[t]he device D according to the invention being intended to take control of at least a portion of the radio resources of at least one of the Nodes B, instead of the RNC to which that Node B is coupled via the lub interface, there are listed hereinafter only the protocols involved in the management of the Node B radio resources". Page 10 of the specification discloses "[t]he device D according to the invention being intended to take control of at least a portion of the radio resources of at least one of the Nodes B, instead of the RNC to

³ The Examiner's Answer dated May 24, 2010 at page 3, citing *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

which that Node B is coupled via the lub interface, there are listed hereinafter only the protocols involved in the management of the Node B radio resources”.

Accordingly, Applicant respectfully submits that the claimed “control device” is clearly enabled by the original specification.

Accordingly, Applicant respectfully requests that the 35 U.S.C. § 112, first paragraph, rejection be withdrawn and the application allowed.

Claim Rejections under alleged prior art

Independent claim 1 recites:

A data management device for a communication installation including at least one base station having resources and at least one terrestrial node connected to a core network and to said base station to control its resources via an interface, the device comprising control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station.

According to this aspect of the invention, a control module of a data management device momentarily, and on command, assumes local control of some or all of the radio resources of one or more Nodes B on place of a terrestrial node (RNC) to which the Nodes B are coupled. The taking of control by the device allows the device to be substituted for the terrestrial node, to enable transmission of traffic (or transfer of data) between the traffic source to which the device is coupled, and a user equipment. Applicant respectfully submits that at least this aspect of the claims is neither taught nor suggested by the cited reference.

First, Applicant respectfully submits that the Examiner has not articulated with any specificity how the claimed “data management device” reads on the cited reference. The Examiner fails to provide specific support in the body of the rejections for this aspect of the

claimed invention.⁴ However, in the “Response to Arguments” section of the final Office Action of November 27, 2007,⁵ the Examiner attempts to cure this deficiency by citing FIG. 1 and column 9, lines 32-54 of Torikka as allegedly disclosing the claimed “data management device”, and asserts:

The terminology used to refer to the data management device of the prior art may be different than that which is used in the instant application. Nonetheless, Torikka discloses Radio Network Control (RNC) also known as Base Station Controller (BSC), which includes control unit for determining the system requirement for the allocation of resources due to a change in the functionality of the system resources (see e.g. fig. 1 and col. 9 lines 32-54).⁶

Applicant respectfully submits that the Examiner’s position is severely flawed for at least the following reasons. Column 9, lines 32-54 of Torikka, which the Examiner cites as allegedly disclosing this feature of the claim, merely discloses an operation for changing the functionality of system resources in a telecommunications network, wherein a control unit determines that the telecommunication system requires a different allocation of resources, and reconfigures several Asynchronous transfer mode Multiplication Boards (AMBs), so that the necessary changes are performed. If a need for a change in the functionality of a telecommunications system arises, a system control unit determines that the telecommunication system requires a different allocation of resources than before. The functionality of an application processor and Asynchronous transfer mode Multiplication Boards is reconfigured such that necessary changes are performed.

⁴ See for example page 3 of the Office Action dated February 8, 2007 and page 2 of the final Office Action dated November 27, 2007.

⁵ Page 3 of the Final Office Action.

⁶ Pages 9-10 of the final Office Action.

Applicant respectfully submits that nothing in this cited portion (or any other portion) of Torikka teaches or suggests a data management device which includes control means configured to be coupled to a traffic source, and which takes local control, on command, of at least a portion of the resources of a base station, instead of a terrestrial node, to enable transfer of data between the traffic source and the base station, as required by independent claim 1.

Further, the relevance of this cited portion of Torikka to the claimed invention remains unclear to Applicant. Nowhere does this cited portion of Torikka teach or suggest a data management device which takes control, on command, of at least a portion of the resources of a base station instead of a terrestrial node, to enable transfer of data between a traffic source and the base station, as required by the claim.

The Examiner appears to take the position that the claimed “data management device” allegedly reads on the Radio Network Control (RNC) of Torikka. However, the present invention clearly discloses that the Data Management Device (D) is separate from the RNC (FIG. 2) and can be substituted for the RNC (at least at page 12, lines 13-16). Accordingly, Applicant respectfully submits that the Examiner’s characterization that the claimed “data management device” reads on the RNC of Torikka is clearly erroneous and unsound.

The Examiner further asserts:

In response to applicant’s argument that “control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order

to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.²

Applicant respectfully disagrees with the Examiner's position and submits that the structural difference between the claimed invention and the prior art is quite clear. There is no teaching or suggestion in the cited references of a data management device comprising control means configured to be coupled to a traffic source and to an interface. Further, and contrary to the Examiner's assertion, the prior art (Torikka) is not capable of performing an intended use of the claimed invention, since there is no teaching or suggestion in Torikka of any structure which is configured to take local control, on command, of a portion of resources in a base station, instead of a terrestrial node, to enable transfer of data between a traffic source and the base station.

The Examiner appears to take the position that the claimed "terrestrial node" reads on the Radio Network Controller (RNC) (or Base Station Controller (BSC)) (14) of Torikka. In the claimed invention, the data management device takes control away from the terrestrial node. This directly contradicts Torikka, which discloses that the BSC controls the allocation of resources (column 9, lines 37-40) and the switching of connections between mobile stations (column 4, lines 44-52). Nothing in Torikka indicates that this control is taken away from the BSC.

The Examiner further asserts that:

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.³

² Page 10 of the Office Action.

Applicant respectfully submits that the Examiner's position is unsound. Applicant's invention is entitled "A Device for taking Control of Resources in a Communication Network in order to insert traffic". Applicant's original specification (for example, FIGS. 1-8) discloses a data management device (D) which comprises control means (M) configured to be coupled to a traffic source (TS), and which takes control of at least a portion of the resources of a base station (for example, pages 10-11 of the original specification), instead of a terrestrial node (for example, page 12 of the original specification), and enables the transfer of data from the traffic source to the base station (for example, page 12 of the original specification).

Claim 1 recites:

A data management device for a communication installation including at least one base station having resources and at least one terrestrial node connected to a core network and to said base station to control its resources via an interface, the device comprising control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station.

Accordingly, Applicant respectfully submits it is quite clear that claim 1 is drawn to limitations which define the operation and apparatus of Applicant's disclosed invention. Applicant further submits that the claimed invention clearly distinguishes over the cited prior art, since there is no teaching or suggestion in the cited prior art of a data management device which includes "control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base

⁸ Page 2 of the Advisory Action dated March 17, 2008.

station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station” as recited in independent claim 1.

The Examiner further asserts:

Applicant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus Applicant intends that a broader interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections.²

Applicant respectfully submits that the Examiner’s position is severely flawed for at least the following reasons.

First, it is well established that Applicant is entitled to draft claims as broadly as supported by the specification. Second, there is simply no requirement that Applicant has to amend the claims in order to narrow the claim language or to construe a narrower meaning or interpretation of the limitations. Applicant may choose to amend the claim language to distinguish over the prior art if the claimed invention reads on the prior art. However, in this instance, Applicant respectfully submits that the claimed invention does not read on the cited art. Accordingly, Applicant does not have to amend the claimed subject matter. Third, contrary to the Examiner’s assertion, Applicant does not have to argue a narrower interpretation of the claims or amend the claims. Fourth, although it may be true that during examination the claims may be broadly interpreted in light of the specification, Applicant notes that the standard for claim interpretation is not the broadest possible meaning of the claim terms, but rather the broadest *reasonable* interpretation consistent with the specification. See MPEP 2111. Applicant

² Page 10 of the final Office Action dated November 27, 2008.

submits that the Examiner's interpretation of the claim language is wholly unreasonable since the claimed data management device certainly does not read on the teachings of Torikka.

The Examiner further asserts:

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims.¹⁰

The Examiner's assertion that Applicant intends that a broad interpretation be given to the claims is clearly erroneous. Applicant expects that each limitation of the claim would be considered and interpreted in light of the specification.

Further, Applicant finds the Examiner's assertion that Applicant has failed to supply arguments commensurate in scope with the claims, unclear. Applicant has continually and consistently argued that Torikka does not teach or suggest all of the features of the claims, and clearly set forth features of the claimed invention that were not disclosed by the cited references¹¹.

Accordingly Applicant respectfully submits that independent claim 1 should be allowable because the cited reference does not teach or suggest all of the features of the claim. Claims 2-21 should also be allowable at least by virtue of their dependency on independent claim 1.

¹⁰ Page 11 of the Office Action.

¹¹ See for example (1) pages 10-11 of the Amendment filed on May 8, 2007 and (2) pages 9-15 of the Response filed on September 5, 2007.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Mark E. Wallerson/

Mark E. Wallerson
Registration No. 59,043

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 26, 2010